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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,224	02/14/2001	Steven R. Slawson	281-345	1587

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 01/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,224

Applicant(s)

SLAWSON ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the Pre-Amendment (Paper No. 3) filed by applicant on 07/17/2001.

Drawings

2. The drawings contain six sheets of figures 1A-4E filed by applicant have been received by the Office.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. The disclosure is objected to because of the following informalities: a) Page 10: line 24, the phrase thereof "Application Serial No. 09/198,545," should be deleted because the mentioned application is now U.S. Patent No. 6,065,837 which information is clearly provided in same page on line 23; b) Page 12: line 21, the description thereof "The walls of the third bellows 47" should be changed to ---The walls 47 of the third bellows 43---; and on lines 22-23, the description thereof "the walls of the first and second bellows 45, and 46." should be changed to ---the walls 45 and 46 of the first and second bellows 41 and 42, respectively---. The reason of that correction is that applicant has used the numerical references, 41, 42, and 43 for the first, second and third bellows, respectively (see same page on lines 19-21); c) Page 12: line 23 and page 13:

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line 9, applicant should be consistent in use of the references so that the references referred in the specification and the drawings match to each other. For instance, page 12: line 23, "2e" should be changed to -2E--and page 13: line 9, "1a" should be changed to -1A--; d) Page 13: line 18 and page 14: line 12, "2A-2H" should be changed to -2A-2G--. Applicant should note that the drawings do not have any figure labeled as figure 2H. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

Claim Objections

5. Claims 5 and 11 are objected to because of the following informalities.

Appropriate correction is required.

a) In claim 5: on line 3, "said observer" should be changed to -an observer--. The reason of this suggestion is that the feature "said observer" lacks a proper antecedent basis.

b) In claim 11: on line 2, "said eye viewing device" should be changed to -said housing--. The reason of this suggestion is that the base claim recites an eye viewing device (see claim 1) having a housing and an eyecup, and the specification teaches that the eyecup is detachably attached to the housing.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 29 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by

Cook (U.S. Patent No. 6,190,310).

+ Yavich et al (29, 30)
32-33
2137

Cook discloses a disposable otoscope. The otoscope comprises a housing having an operator end and a patient end. An attachment interface (20) is formed on the patient end of the housing; and an attachment in the form of a conical member (22) disposed in the attachment interface. The connection between the attachment interface comprises a lid formed on the conical member and ribs formed on the attachment interface

8. Claims 1-4, 11, 13-16, 23 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Yablonski et al (U.S. Patent No. 3,929,124).

Yablonski et al disclose an optical apparatus for examining/observing a patient's eye. The apparatus as described at columns 2-4 and shown in figures 1-3 comprises a housing or an eye viewing device (14) having a patient end and an observing end, and an eyecup (10) which is removably attached to the patient end of the housing (14). The eyecup (10) comprises a patient end and an observing end wherein the patient end comprises a flange configured bottom surface (10a) sized to substantially correspond to the eye orbit of the patient's

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eye and an interior (10b) sized to accommodate a patient's eyelashes; and the observing end (10c-d) is removably attached to the patient end of the housing (14) via a grooved circular retaining clip.

9. Claims 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Chisum et al (U.S. Patent No. 3,903,871).

Chisum et al disclose an optical apparatus for examining/observing a patient's eye. The apparatus as described at columns 2-4 and shown in figures 1a, 1b and 3 comprises a housing or an eye viewing device (14) having a patient end and an observing end, and an eyecup (12) which is removably attached to the patient end of the housing (14). The eyecup (12) comprises a patient end and an observing end wherein the patient end comprises a flange configured bottom surface (12a) sized to substantially correspond to the eye orbit of the patient's eye and an interior (12b) sized to accommodate a patient's eyelashes; and the observing end (12c, 12d) is removably attached to the patient end of the housing (14). At columns 3-4 and fig. 3, Chisum et al suggest a set of steps for operating their apparatus in which the eyecup (12) after attached to the housing (14) is aligned and then pressed to a position to contact to the eyelids of a patient's eye via the use of an elastic band (38).

10. Claims 13-15, 23, 29 and 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Volk (U.S. Patent No. 5,255,025).

See Volk, columns 4-7 and figs. 1-2 and 5-6.

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11. Claims 29, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Yarush et al (U.S. Patent No. 5,879,289).

Yarush et al disclose a hand-held endoscope system. The endoscope system comprises a housing having an operator end and a patient end; an attachment interface in the form of a lens tube (32) connected at the patient end of the housing; and an attachment disposed in the attachment interface. At columns 16-19 and shown in figure 12(a-f), the attachment can be an eyecup or an otoscope.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Patent No. 6,190,310).

Cook discloses a disposable otoscope. The otoscope comprises a housing having an operator end and a patient end. An attachment interface (20) is formed on the patient end of the housing; and an attachment in the form of a conical member (22) disposed in the attachment interface. The connection between the attachment interface comprises a lid formed on the conical member and ribs formed on the attachment interface. While Cook does not disclose that the arrangement of the ribs and lip as the one claimed in the inventive device; however, it would have been obvious to one skilled in the art to rearrange the

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positions of the ribs and the lip, i.e., the lip is formed on the attachment interface and the ribs formed in the conical member, to connect the two mentioned together. See *In re Japikse*, 86 USPQ 70 (CCPA 1950).

14. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yarush et al (U.S. Patent No. 5,879,289) with or without Monroe et al (U.S. Patent No. 5,662,5860).

The device as provided by Yarush et al meets all of the limitations of the device as claimed in claims 33-36 except the feature concerning the type of attachment disposed in the attachment interface. In other words, Yarush et al do not clearly state that the attachment can be an episcopes or a corneal lens viewing assembly, etc.... However, the use of such attachments is merely that of a preferred embodiments and no criticality has been disclosed. The support for that conclusion is found in the present specification. It is also noted that the attachment in the form of an eyecup or an otoscope is indeed claimed as can be seen in present claims 31 and 32. Furthermore, the interchangeability of an otoscope and an episcopes is clearly suggested to one skilled in the art as can be seen in the system provided by Monroe et al. See column 4 and fig. 2. Thus, absent any critical features concerning the structure, it would have been obvious to one skilled in the art at the time the invention was made to utilize any suitable attachment including an episcopes or a corneal viewing lens, etc... as an attachment for the system provided by Yarush et al for the purpose of satisfying a desired application.

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15. Claims 5-10, 12, 17-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonski et al (U.S. Patent No. 3,929,124) in view of Luning et al (U.S. Patent No. 3,390,931).

The eyecup as provided by Yablonski et al is not made by deformable material for the purpose of alert the observer that the device is in contact with the patient's eye and also for providing a means for pivoting with respect to the patient's eye. However, the use of a deformable material for making an eyecup is suggested to one skilled in the art as can be seen in the eyecup provided by Luning et al. In particular, the eyecup (14) is made by flexible material in the form of plural bellows. It is also noted that the eyecup material is made by opaque material for preventing ambient light and the walls of the flexible eyecup is thinner in the direction facing the observer's eye. See column 3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to use opaque and flexible material for making an eyecup as suggested by Luning et al for the purpose of alerting the time when the eyecup is in contact with the patient's eye, and for the pivoting of the system with respect to the patient's eye while preventing ambient light entering into the field of view defined between the patient's eye and the observer.

16. Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chisum et al in view of Luning et al.

The eyecup as provided by Chisum et al is not made by deformable material for the purpose of alert the observer that the device is in contact with the patient's

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eye and also for providing a means for pivoting with respect to the patient's eye. However, the use of a deformable material for making an eyecup is suggested to one skilled in the art as can be seen in the eyecup provided by Luning et al. In particular, the eyecup (14) is made by flexible material in the form of plural bellows. See column 3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the method derived from the device provided by Chisum et al by using flexible material for making an eyecup as suggested by Luning et al for the purpose of alerting the time when the eyecup is in contact with the patient's eye, and for the pivoting of the system with respect to the patient's eye.

Conclusion

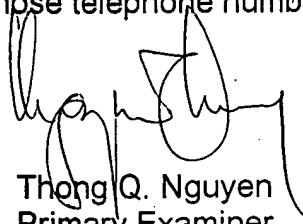
17. The additional references are cited as of interest in that each discloses an eyecup for use with an optical device.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703 308 1687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

January 17, 2002